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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,582	07/25/2003	Peter B. Vander Horn	020130-001510US	3008

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EXAMINER

HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,582

Applicant(s)

VANDER HORN ET AL.

Examiner

Richard G. Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-32 are pending and at issue for examination.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, 25-31, drawn to a hybrid polymerase, classified in class 435, subclass 194.
- II. Claims 12-24, drawn to an polynucleotide encoding a hybrid polymerase and expression vectors and host cells comprising said polynucleotide, classified in class 435, subclass 252.3.
- III. Claim 32, drawn to a method of amplifying a target sequence, classified in class 435, subclass 15.

For inventions I-III above, restriction to one of the following is also required under 35 USC 121. Applicants is required to elect one of inventions corresponding to those hybrid polymerases, their encoding nucleic acids or methods of use of those hybrid polymerases comprising an amino acid sequences related to (a) SEQ ID NO: 24 or (b) SEQ ID NO: 25 or the nucleic acids encoding these amino acid sequences.

For inventions I-III above, restriction to one of the following is also required under 35 USC 121. Applicants is required to elect one of inventions corresponding to those hybrid polymerases corresponding to (c) SEQ ID NO: 2, (d) SEQ ID NO: 4, (e) SEQ ID NO: 6, (f) SEQ ID NO: 8, (g) SEQ ID NO: 10, (h) SEQ ID NO: 12, (i) SEQ ID NO: 14, (j) SEQ ID NO: 16, (k) SEQ ID NO: 18, or (l) SEQ ID NO: 20, or the nucleic acids encoding these amino acid sequences.

The inventions are distinct, each from the other because of the following reasons:

Inventions (a)-(b) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally different polypeptides. Therefore, where structural identity is required, the different sequences have different effects.

Inventions (c)-(l) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally different polypeptides. Therefore, where structural identity is required, the different sequences have different effects.

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the hybrid polymerases of Group I, and the nucleic acid encoding the hybrid polymerases of Group II each comprise a chemically unrelated structure capable of separate manufacture, use and effect. The peptide of Group I is comprised of amino acid sequence and the DNA of Group II is comprised of nucleic acid sequence. The DNA has other utility besides encoding protein such as a hybridization probe, and the proteins can be made synthetically. Additionally, the protein can be

used to perform specific biological function(s) which are independent of the function(s) of the DNA molecule.

Inventions I and inventions III are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptide can be used in a materially different process such as one in which the polypeptide is used to make an antibody.

The nucleic acid of group II is unrelated to the method of groups III, as they are neither used nor made by the method of groups III.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and/or the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is 571-272-0930. The examiner can normally be reached on M-F, 7:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard G Hutson, Ph.D.
Primary Examiner
Art Unit 1652

rg
2/27/2006